

REMARKS

I. Introduction

Claims 17 to 32 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 17 to 32 Under 35 U.S.C. § 112, First Paragraph

Claims 17 to 32 were rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement.

The Final Office Action states that “[r]egarding claim 17, the limitation ‘the at least one first support surface and the at least one second support surface have a lateral clearance from each other’ and ‘the at least one first elastic element bridges the lateral clearance in the form of a first free bridge’ is not understood by an ordinary skill in the art [sic].” (Final Office Action, p. 2). In this regard, the Final Office Action further states that “[a]s best understood by the Examiner and shown in Fig. 3, the first support surface 30 is the surface of the overlapping region of the holding tab 17 and elastic member and the second support surface 31 is the overlapping region of the pocket side wall 8’ and the elastic member. However, as shown in Fig. 2, there is no lateral clearance between first support surface 30 and the at least one second support surface 31 and the disclosure does not show how the lateral clearance 32 is formed in Fig. 3. Fig. 4 shows an embodiment quite different from Fig. 2 with two holding tabs 17 on one side of the elastic member and pocket side wall 8’ on the other side.” (Final Office Action, pp. 2 to 3).

The present rejection is not based upon the proper standard for determining compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph. Rather, the Final Office Action merely conclusorily states that “the breadth of the claims and the nature of the invention is unclear, there is no drawings to described [sic] prior art, there is no direction provided by the inventor, no working example.” (Final Office Action, pp. 3 to 4). Further, it appears that the present rejection reflects an apparent misapprehension between the distinct concepts of **enablement**, under 35 U.S.C. § 112, first paragraph, and **definiteness**, under 35 U.S.C. § 112, second paragraph. An analysis for compliance with the **enablement** requirement requires a determination as to whether the application, when filed, contained sufficient information regarding the subject matter of the claims as to

enable one skilled in the pertinent art to make and use the claimed subject matter without undue experimentation. U.S. v. Telecommunications, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). Among the factors that must be considered in an analysis for compliance with the enablement requirement are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). It is, however, improper to conclude that a disclosure is not enabling based on an analysis of only one of these factors while ignoring one or more of the other factors. That is, a proper analysis must consider all the evidence related to each of these factors. Rather than addressing any of these factors, the Final Office Action contends that certain phrases included in claim 17 are “not understood by an ordinary skill in the art [sic].” As such, the present rejection is plainly deficient with regard to the proper showing required to establish that the enablement requirement is not satisfied.

Notwithstanding the above, Applicant respectfully submits that the Final Office Action has misunderstood the disclosure of the present application. As an initial matter, the at least one first support surface may be on a holding tab 17, and the at least one second support surface may be on a projection of a pocket side wall 8. (Specification, p. 7, lines 33 to 34). Accordingly, it is respectfully submitted that the assertion at page 2 of the Final Office Action that “the second support surface 31 is the overlapping region of the pocket side wall 8’ and the elastic member” is not accurate. Instead, as stated throughout the Specification, the second support surface may be on a projection of a pocket side wall 8. (Substitute Specification, p. 8, lines 30 to 31; p. 9, lines 21 to 22; p. 10, lines 11 to 13; and p. 11, lines 32 to 33).

The Examiner’s attention is also respectfully directed to original claims 1 to 16 and M.P.E.P. § 2164, which plainly sets forth that the claims may themselves provide sufficient enablement to satisfy the requirements of 35 U.S.C. § 112, first paragraph.

In addition, the Final Office Action at page 2 states that “as shown in Fig. 2, there is no lateral clearance between first support surface 30 and the at least one second support surface 31.” However, because Figure 2 shows a cross-section along line II-II of Figure 1, a lateral clearance is not visible from the perspective shown in Figure 2. In the view shown in Figure 2, a lateral clearance would extend in a direction into or out of the page. Thus, it is respectfully submitted that the Final Office Action has misunderstood the perspectives of the Figures and the direction in which a lateral clearance between a first support surface and at least one second support surface is measured. In this regard, Figures 3 to 7 are exemplary, schematic views of a device 20 of Figure 2, viewed radially towards the center of the shaft 14 (or the axis of rotation 15) of Figure 2. Thus, Figures 3 to 7 clearly show a lateral clearance between a first support surface and at least one second support surface, which lateral clearance is not visible from the perspective shown in Figure 2. Accordingly, contrary to the assertion of the Final Office Action, it is respectfully submitted that the disclosure does show how a lateral clearance is formed in Figures 3 to 7, consistent with the remaining Figures.

Further, the Final Office Action at page 3 states that “Fig. 4 shows an embodiment quite different from Fig. 2 with two holding tabs 17 on one side of the elastic member and pocket side wall 8’ on the other side.” However, as more fully set forth above, it is respectfully submitted that the Final Office Action has misunderstood the perspectives of the Figures. Because Figure 2 shows a cross-section along line II-II of Figure 1, holding tabs 17 (if there are multiple holding tabs) would be lined up in a direction into or out of the page in the view shown in Figure 2, such that multiple holding tabs may not be visible in Figure 2. However, when viewing a device 20 of Figure 2 from the perspective of Figures 3 to 7 (that is, when viewing a device 20 of Figure 2 radially towards the center of shaft 14), the holding tabs 17 would be visible as is schematically shown in Figures 3 to 7. Further, nowhere does the present application indicate that the exemplary embodiments of Figures 3 and 4 are the same as the exemplary embodiment of Figure 2. Instead, as stated explicitly in the Substitute Specification, “Figure 3 shows a schematic representation of a damping device[, and] Figure 4 shows a schematic representation of a further exemplary embodiment of a damping device.” (Substitute Specification, p. 5, lines 13 to 16). Thus, Figures 3 and 4 schematically show further

exemplary embodiments of the damping device that may not necessarily be the same as the exemplary embodiment shown in Figure 2.

Moreover, the Final Office Action at page 4 states that “Figs. 1 and 9 show no lateral clearance between tabs 17 and wall 8, 8’.” However, Figures 1 and 9 show longitudinal, partial cross-sections of a driving assembly. Because Figures 1 and 9 show partial cross-sections in the area of a device 20, it is respectfully submitted that pocket side walls 8, 8’ are not even shown in these views. Instead, each of the side walls 8, 8’ would be situated in a plane parallel to the page, either above or below the plane of the cross-section shown in Figures 1 and 9. Thus, a lateral clearance between tabs 17 and side walls 8, 8’ is not visible in Figures 1 to 9 because side walls 8, 8’ are not shown in these Figures. Therefore, as more fully set forth above, it is respectfully submitted that the Final Office Action has misunderstood the perspectives of the Figures.

In addition, the Final Office Action at page 4 states that “Fig. 7 appears to show side walls 8 and 8’ similar to Fig. 2 but there is a gap between the necessary structural connections such as tab 17 is broken into two pieces in radial direction.” As more fully set forth above, it is respectfully submitted that the Final Office Action has misunderstood the perspectives of the Figures, particularly with regard to Figures 2 and 7. Further, the Final Office Action’s assertion that “tab 17 is broken into two pieces in radial direction” is not accurate. As more fully set forth above, the holding tabs 17, as shown in Figure 7, are not aligned radially, but instead aligned axially along a line parallel to the axis of rotation 15, such that the holding tabs 17 of Figure 7 may correspond to the holding tabs 17 shown in each of Figures 1 and 9.

Concerning the reference to “no working example” at page 4 of the Final Office Action, the Examiner’s attention is respectfully directed to, for example, M.P.E.P. § 2164.02, which plainly states that “[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed.” (emphasis added).

In view of all of the foregoing, Applicant respectfully submits that the subject matter of the present application is sufficiently described in the Specification and the Figures “in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.”

That the Final Office Action reflects an apparent misapprehension of the enablement requirement is plainly evident from at least the following statements:

“Regarding claim 17, the limitation . . . **is not understood** by an ordinary skill in the art [sic]” and “the Examiner has clearly pointed out why the disclosure of the invention **is not understood** to an ordinary skill in the art [sic].” Whether a claim feature may be **understood** and whether a patent application specification may be **understood** are entirely irrelevant to the question of whether a claim is sufficiently enabled under 35 U.S.C. § 112, first paragraph.

Accordingly, it is respectfully submitted that the Final Office Action plainly fails to establish that claims 17 to 32 do not comply with the enablement requirement.

It is therefore respectfully requested that the rejection be withdrawn.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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